

Applicants: David M. Stern et al.
U.S. Serial No.: 09/394,204
Filed: September 10, 1999
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REMARKS

Claims 20 and 27-30 are pending in the subject application. Applicants have herein amended claim 20 to more particularly point out what they consider to be the invention. Support for this amendment can be found, *inter alia*, on page 14, line 23 of the specification. Applicant maintains that this Amendment raises no issue of new matter. Upon entry of this Amendment, claims 20 and 27-30 will still be pending and under examination.

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 20 and 27-30 under 35 U.S.C. §112, first paragraph, as allegedly not enabled such that a person skilled in the relevant art would be able to make or use the invention commensurate in scope with the claims. Specifically, the Examiner alleges that while the specification is enabling for a binding assay using the specific purified ERAB polypeptide of SEQ. ID. NO: 2 and the amyloid-beta polypeptide structurally described on pages 1-2 of the specification, it does not reasonably provide enablement for any method in which the required components necessary to practice the method are structurally and functionally uncharacterized (i.e., as it relates to generic uncharacterized ERAB polypeptides fragments and polymorphisms thereof).

In response, applicants respectfully traverse. Claim 20, as amended, provides a method for evaluating the ability of an agent to inhibit binding of human ERAB polypeptide (SEQ. ID. NO: 2), or a fragment, to amyloid-beta peptide. Applicants maintain that the human ERAB polypeptide is sufficiently characterized such that one

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skilled in the relevant art could make or use the invention commensurate in scope with the claims. Applicants direct the Examiner's attention to page 14, line 23 of the specification which states "[v]ariants of an ERAB polypeptide may include biologically active *fragments* of naturally occurring ERAB polypeptide..." [emphasis added]. Applicants maintain that the term "fragment" is well-known in the art and that one skilled in the art would be able to practice the claimed invention.

The Examiner also rejected claims 20 and 27-30 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that no proper antecedent or conception in context with that described within the specification is apparent for the new recitation of the phrase "polymorphisms thereof," thereby constituting new matter.

In response to, and without conceding the correctness of the Examiner's rejection, applicants note that in amended claim 20, the phrase "polymorphisms thereof" is not recited. Accordingly, the Examiner's rejection thereof is obviated.

In view of the above remarks, applicants maintain that claim 20, and dependent claims 27-30, satisfy the requirements of 35 U.S.C. §112, first paragraph.

Summary

In view of the remarks made herein, applicants maintain that the claims pending in this application are in condition for allowance.

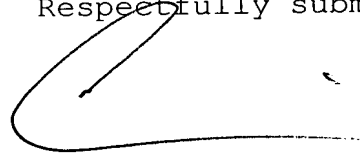
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Accordingly, allowance is respectfully requested.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

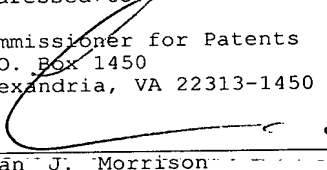
Respectfully submitted,



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